

MAY 31 2006

## MYERS BIGEL SIBLEY &amp; SAJOVEC, P.A.

Patent Attorneys  
4140 Parklake Avenue, Suite 600  
Raleigh, North Carolina 27612 USA  
or  
P.O. Box 37428  
Raleigh, North Carolina 27627 USA  
Tel: (919) 854-1400  
Fax: (919) 854-1401

TELECOPIER TRANSMISSION  
COVER SHEET

Date: May 31, 2006

File Number: 5577-115CX  
Serial No.: 09/207,945

Telecopier No.: 571-273-8300

To: Mail Stop Appeal Brief - Patents  
Examiner: T. Huynh  
Group Art Unit: 2178

Company: United States Patent and Trademark Office

From: D. Randal Ayers

Number of Pages: 37  
(including cover)

Return fax to: Michele

If there is a problem with this transmission, please call (919) 854-1400.  
Our fax number is (919) 854-1401.

Confidentiality Note

The information contained in this facsimile message is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby prohibited. If you have received this telecopy in error, please immediately notify us by telephone and return the original message to us at the address above via the United States Postal Service. THANK YOU.

MAY 31 2006

Attorney's Docket No. 5577-115.CXPATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Nguyen et al.

Serial No.: 09/207,945

Filed: December 9, 1998

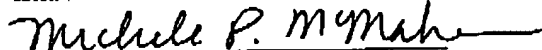
For: SYSTEMS, METHODS AND COMPUTER PROGRAM PRODUCTS FOR ASSOCIATING  
DYNAMICALLY GENERATED WEB PAGE CONTENT WITH WEB SITE VISITORS

Group: 2178

Confirmation No.: 7467

Examiner: T. Huynh


May 31, 2006

Mail Stop Appeal-Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**CERTIFICATION OF FACSIMILE TRANSMISSION**I hereby certify that this correspondence is being transmitted  
by facsimile to the U.S. Patent and Trademark Office via  
facsimile number 571-273-8300 on May 31, 2006  
Michele P. McMahan**TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION--37 C.F.R. § 41.37)**1. Transmitted herewith is the APPEAL BRIEF for the above-identified application,  
pursuant to the Notice of Appeal filed on March 22, 2006.2. This application is filed on behalf of  
☐ a small entity.3. Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:  
☐ small entity \$250.00  
☒ other than small entity \$500.00

Appeal Brief fee due \$500.00

☒ You may charge Deposit Account 09-0461 for the Appeal Brief and any  
additional charges or deficiency in funds.

Respectfully submitted,

D. Randal Ayers  
Registration No. 40,493

RECEIVED  
CENTRAL FAX CENTER

Attorney's Docket No. 5577-115.CX

**MAY 31 2006**

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Nguyen et al.

Serial No.: 09/207,945

Filed: December 9, 1998

For: SYSTEMS, METHODS AND COMPUTER PROGRAM PRODUCTS FOR ASSOCIATING  
DYNAMICALLY GENERATED WEB PAGE CONTENT WITH WEB SITE VISITORS

Group: 2178

Confirmation No.: 7467

Examiner: T. Huynh

May 31, 2006

Mail Stop Appeal-Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted  
by facsimile to the U.S. Patent and Trademark Office via  
facsimile number 571-273-8300 on May 31, 2006

*Michele P. McMahan*  
Michele P. McMahan

**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

Sir:

This Appeal Brief is filed pursuant to the *Notice of Appeal to the Board of Patent Appeals and Interferences* filed March 22, 2006.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. § 1.136(a). Any additional fees believed to be due may be charged to Deposit Account No. 09-0461.

**Real Party In Interest**

The real party in interest is assignee International Business Machines Corporation, Armonk, New York.

**Related Appeals**

Appellant is aware of no interferences that would be affected by the present appeal. Appellant does note that United States Patent Application Serial No.: 09/537,363 (the '363

06/01/2006 110111 00000050 090461 09207945  
01 FC:1402 500.00 DA

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 2

application), which is related to the present application, was appealed on August 12, 2004 and has been assigned Board of Patent Appeals and Interferences Appeal No. 2006-1731. Appellant also notes that the claims of the '363 application differ from those of the present application and, therefore, believes that the outcome of the appeal of the '363 application would not affect the present appeal. No decision has been provided in the appeal in the '363 application and, therefore, a Related Proceedings Appendix is not provided.

Appellant further notes that the present application was subject to a prior appeal to the Board of Patent Appeals and Interferences, which was assigned as Appeal No. 2004-1627. A decision in Appellants favor was issued in this appeal on November 22, 2004. A copy of that decision is attached in the Related Proceedings Appendix.

#### **Status of Claims**

Claims 1-48 remain pending, each of which stands finally rejected. Appellants appeal the final rejection of Claims 1-48. The attached Claims Appendix presents the claims at issue as finally rejected in the Office Action of December 28, 2005 and the Advisory Action of February 24, 2006.

#### **Status of Amendments**

The attached Claims Appendix presents the claims as they currently stand (i.e., as presented in the Amendment dated September 27, 2005). The present application is a *Request for Continued Examination* application that was filed on December 17, 2004. Prior to the filing of the present *Request for Continued Examination* application, this case had been appealed to the Board of Appeals and Interferences. The Board of Appeals and Interferences ruled in Appellants' favor as to the patentability of the pending claims over the cited art, and a Notice of Allowance was issued by the patent examiner in response to this ruling. Thereafter, the present *Request for Continued Examination* application was filed in order to submit to the Patent Office references which had been cited in the above-mentioned related application.

A *Response* was filed in this *Request for Continued Examination* application on September 27, 2005. This September 27, 2005 *Response* was entered. A *Response to Final Office Action* was filed on January 31, 2006. The January 31, 2006 *Response to Final Office*

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 3

*Action* was entered in the Advisory Action dated February 28, 2006, but was deemed insufficient to place the case in condition for allowance. Thus, each of the two amendments in this case have been entered. Appellants requested and received Pre-Appeal Review in this case. The Patent Office declined to withdraw the pending rejections in response to this review.

### **Summary of Claimed Subject Matter**

The present invention provides methods, systems and computer program products that may be used to collect information about the preferences of Web site visitors and/or to facilitate delivering personalized content to those Web site visitors in response to requests for Web pages. (Application at 4).

Independent Claim 1 is directed to a method of associating dynamically generated Web page content with a user who requests a Web page from a Web server. As shown in the example of Fig. 2 of the present application, a user, via Web client 10, requests a Web page 30 from Web server 12. The request may be sent, for example, over the Internet 14. In response to this request, the Web server 12 stores a record of the user request within Web server logging facility 16. The Web server 12 further dynamically generates the requested Web page 30 using a template 18 and one or more content objects 20 (which may be stored in database 19). The content object 20 has a unique identifier associated therewith. This unique identifier may be generated via a hashing function. The generated Web page 30 is served to the Web client 10. Moreover, the unique identifier that is associated with the content object 20 is appended to the user request record that is stored in the Web server logging facility 16.

In certain embodiments of the present invention, each time a user requests additional content, the respective identifiers associated with the requested content object(s) may be appended to the respective user request record. The user request record may further include time stamps that may be used to determine the amount of time a user spends viewing particular content. The stored records of user requests can be analyzed to determine user preferences with respect to Web page content. The choices of Web pages requested by the user, combined with information about what content was presented on each requested Web page and the amount of time spent viewing that content, can provide insight into the preferences of a user. The efficacy

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 4

---

of certain content within a viewed Web page can also be determined, for example, by identifying content that was ignored by users (e.g., hyperlinks that are not selected by the user).

Independent Claim 8 is also directed to directed to methods of associating dynamically generated Web page content with a user who requests a Web page from a Web server. As shown in the example of Fig. 2 of the present application, a user, via Web client 10, requests a Web page 30 from Web server 12. The request may be sent, for example, over the Internet 14. The Web server 12 stores a record of the user request within Web server logging facility 16. The Web server 12 generates the requested Web page 30 using a template 18 and first and second content objects 20 (which may be stored in database 19). The first and second content objects 20 each have a unique identifier associated therewith. This unique identifier may be generated via a hashing function. A layout of the template 18 for the requested Web page 30 is retrieved. This template layout 18 defines where the first and second content objects 20 are displayed on the Web page 30. The first and second content objects 20 are retrieved and combined with the layout template 18 to generate the requested Web page 30. This generated Web page 30 is served to the Web client 10. Moreover, the first and second unique identifiers that are associated with the respective first and second content objects 20 are appended to the user request record that is stored in the Web server logging facility 16.

Independent Claim 12 is directed to directed to methods of collecting information about the preferences of Web site visitors. Pursuant to the methods of Claim 12, dynamically generated Web page content is associated with a user who requests a Web page 30 from a Web server 12. As shown in the example of Fig. 2 of the present application, a user, via Web client 10, requests a Web page 30 from Web server 12. The Web server 12 stores a record of the user request within Web server logging facility 16. The Web server 12 generates the requested Web page 30. The Web page 30 includes a content object 20 that has a unique identifier associated therewith. This unique identifier may be generated via a hashing function. The generated Web page 30 is served to the Web client 10. The unique identifier that is associated with the content object 20 is appended to the user request record that is stored in the Web server logging facility 16.

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 5

The remaining independent claims are system and computer program products counterparts of the independent method claims and are grouped together with the independent method claims for purposes of the present appeal. As such, further discussion of these claims is unnecessary.

### **Grounds of Rejection to be Reviewed on Appeal**

1. The rejections of Claims 1-6, 8-22, 24-38 and 40-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,128,663 to Thomas ("Thomas") in view of U.S. Patent Publication No. 2003/0093384 A1 to Durst Jr., et. al. ("Durst") and U.S. Patent Publication No. 2001/0032254 A1 to Hawkins ("Hawkins").

2. The rejections of Claims 7, 23 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, Durst, Hawkins and U.S. Patent No. 5,991,735 to Gerace.

### **Grouping of Claims**

Claims 1-48 stand rejected as obvious under 35 U.S.C. § 103. For the purposes of this appeal, Appellants submit that Claims 1, 3-4, 6-8, 10, 12, 14-15, 17, 19-20, 22-24, 26, 28, 30-31, 33, 35-36, 38-40, 42 and 44 and 46-47 may be considered as standing or falling together (Group I), Claims 2, 9, 13, 18, 25, 29, 34, 41 and 45 may be considered as standing or falling together (Group II), Claims 5, 11, 16, 21, 27, 32, 37, 43 and 48 may be considered as standing or falling together (Group III). Appellants submit that the above-listed groups of claims are separately patentable for the reasons discussed below.

### **Argument**

#### **I. Introduction**

Each of the claims of the present application stands rejected as obvious under 35 U.S.C. § 103. A determination under Section 103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 6

skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office has the initial burden under Section 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art references cited in the rejection, when combined, must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings in the manner suggested. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, in support of a Section 103 rejection, particular evidence from the prior art must be provided showing why a skilled artisan, with no knowledge of the claimed invention, would have combined the cited references in the manner claimed in the rejection. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).



In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 7

Appellants respectfully submit that the pending claims are patentable over the cited references because the cited combination fails to disclose or suggest all of the recitations of the pending claims, and because the reasoning behind such combination has not been established. The patentability of the pending claims is discussed in detail hereinafter.

## **II. The Group I Claims are Patentable Over the Cited References**

The Group I claims comprise Claims 1, 3-4, 6-8, 10, 12, 14-15, 17, 19-20, 22-24, 26, 28, 30-31, 33, 35-36, 38-40, 42 and 44 and 46-47. The Group I claims include nine independent claims, namely Claims 1, 8, 12, 17, 24, 28, 33, 40 and 44. The rest of the Group I claims depend from one of these independent claims, and hence separate arguments against the rejections will not be presented with respect to the dependent Group I claims. Moreover, Claims 17 and 33 are, respectively, system and computer program product versions of the method of Claim 1, Claims 24 and 40 are, respectively, system and computer program product versions of the method of Claim 8, and Claims 28 and 44 are, respectively, system and computer program product versions of the method of Claim 12. Accordingly, separate arguments will not be presented here with respect to Claims 17, 24, 28, 33, 40 and 44. In addition, Claims 1, 8 and 12 include several common recitations, including each of the recitations discussed below that Appellants' contend is not taught or suggested by the cited references. Accordingly, Appellants' argument with respect to the Group I claims will focus solely on Claim 1, although the argument applies equally well to Claims 8 and 12. Thus, in summary, while Appellants' only explain herein the reasons that independent Claim 1 is patentable over the cited art, it will be understood that the exact same arguments are equally applicable to the remainder of the Group I claims

Independent Claim 1 recites:

1. A method of associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the method comprising the following steps performed by the Web server:

storing a record of the user request within a Web server log;

generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 8

serving the generated Web page to the Web client; and  
**appending the stored record of the user request with the unique identifier associated with the content object** included within the generated Web page.

The Final Office Action ("Final Action") cites to Thomas as teaching each of the recitations of Claim 1 except for (1) the web server log (which is allegedly taught by Durst) and (2) generating the unique identifier via a hashing function (which is allegedly taught by Hawkins). (Final Action, pp. 2-3). However, as shown below, the cited references fail to disclose at least two recitations of each of the Group I claims, and hence the combination of the cited references fails to establish *prima facie* rejections under 35 U.S.C. § 103. In addition, Appellants submit that motivation to combine the cited references in the manner of the pending rejections has also not been established. Accordingly, Appellants respectfully submit that the rejections of the Group I claims should be withdrawn for at least each of the three independent reasons discussed below.

A. **Thomas Does Not Teach Storing a Record of a User Request**

Claim 1 recites "storing a record of the user request within a Web server log." The Final Action states that Thomas, at Col. 4, lines 23-52, teaches "storing a record of a user request within a web server." (Final Action, p. 3). The cited portion of Thomas states:

[T]he remote server encourages the user to login to or register with one of its web pages so that the remote server can identify the user against its database of users. Once the user is identified, the remote server determines or retrieves an appropriate demographic identifier for the user. . . . [O]nce the appropriate demographic identifier is known, it can be transmitted between remote servers and/or between a local browser and a remote server in various ways. One way is to embed the demographic identifier into the pages delivered by the remote server to the local browser.

(Thomas at Col. 4, lines 26-43). Thus, Thomas discloses that (1) a user can login to a web page of the remote server, (2) the server retrieves a demographic identifier for the user and (3) the demographic identifier may be appended to a delivered web page. As is clear from the above quote, the information that is obtained (and possibly stored) in Thomas **is user demographic information**. However, as the preamble and first clause of Claim 1 make clear, the recitation "storing a record of the user request" in Claim 1 refers to **storing a record of a user's request for a Web page**. While the demographic information of Thomas may be appended to a request

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 9

for a web page, Thomas does not suggest that the remote server stores the request for the web page anywhere. In fact, the Advisory Action as much as concedes this by stating that "it is noted that in order to receive the demographic identifier and the request information, such information must [be] stored (in memory of the server)." (Advisory Action, p. 2). While it is possible that the remote server of Thomas might transiently copy a web page address into memory in retrieving a requested web page, this would not comprise "storing a record of the user's request", let alone storing a record of the request "within a Web server log" as recited in Claim 1. Consequently, as Thomas does not teach or disclose "storing a record of a user request within a web server", the rejection of Claim 1 should be withdrawn.

**B. Durst and Thomas Cannot Properly Be Combined**

The Final Action concedes that "Thomas does not explicitly disclose [that the record of a user request is stored in a] web server log." (Final Action, p. 3). In order to supply the missing teaching, the Final Action cites to Durst as teaching that "demographic and user information is stored in a web server log." (*Id.*). Even if Durst actually disclosed storing "a record of a user's request [for a web page] within a Web server log" as recited in Claim 1 (which Applicants dispute), there clearly is no motivation to combine Thomas and Durst in the manner suggested. As discussed above, the system of Thomas does not use or store a record of a user's request for a web page. Instead, the system of Thomas selects content objects using demographic information. As such, in the system of Thomas there is no reason to store records of user's web page requests, and one of skill in the art would not have been motivated to modify the system of Thomas based on Durst. Moreover, Thomas is directed to methods for "customization of information content provided to a requestor over a network", whereas Durst is directed to a "scanner enhanced remote control unit and system for automatically linking to online resources." With all due respect, the combination of these two disparate and unrelated references appears to be a classic "hindsight" rejection, wherein the present application is read and understood and an attempt is made to selectively build the invention from the prior art based on this understanding.

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 10

---

C. Thomas Fails to Teach Appending Content Identifiers to Stored Records of User Requests

Claim 1 also recites "appending the stored record of the user request with the unique identifier associated with the content object." Thus, in the method of Claim 1, unique identifiers that are associated with content objects (e.g., a web page banner) are appended to the record in the log file of the users request for a web page.

The Final Action is internally inconsistent in identifying the portion of Thomas that allegedly discloses the "appending" recitation of Claim 1. The Final Action first points to Col. 7, lines 18-30 of Thomas as disclosing the "appending" recitation. (Final Action, p. 3). However, what this portion of Thomas discusses is appending demographic information to the actual request for a web page that is sent to the server. The cited portion of Thomas does not disclose appending a unique identifier that is associated with the content objects to anything, as the demographic information is (1) not a "unique identifier" and (2) is not "associated with the content objects." Moreover, the demographic information is appended to a request for a web page. In contrast, what the last clause of Claim 1 recites is that the unique identifiers are appended to a record in a log file. Accordingly, the first cited portion of Thomas fails to teach at least three different aspects of the "appending" recitation.

The Response to Arguments section of the Final Action cites to Col. 4, lines 49-51 and Col. 5, line 15 through Col. 6, line 40 of Thomas as disclosing the "appending" recitation of Claim 1. (Final Action, p. 10). The Final Action contends that these portions of Thomas disclose (1) that a user requests a second HTML web page 104 via a hyperlink button 108 on a first HTML web page, (2) that a record of the user who requests the web page is stored along with demographic information on the user, (3) the user clicks on the hyperlink 110 to send the user's request for the first HTML web page to the remote server with the demographic information appended thereto so that the first server can display the requested web page to the user with an appropriate advertising banner that is selected based on the demographic information. (*Id.*). These portions of Thomas also fail to disclose the "appending" recitation of Claim 1 for at least two independent reasons.

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 11

First, what Claim 1 states is that a "unique identifier" is appended to the stored record of a user's request for a web page. The rejection points to the demographic information as the appended information. However, in Thomas, the demographic information is appended to the actual request for a web page that is sent to the server. An actual request for a web page is very different from a stored record of a user's request, which is what Claim 1 recites the unique identifier is appended to.

Second, the demographic information of Thomas (e.g., a particular user's interests, preferences, hobbies, preferred greeting name, etc.; see Thomas at Col. 4, lines 16-20) does not comprise a "unique identifier associated with the content object included within the generated Web page" as recited in Claim 1. While Applicants will not debate here whether or not such demographic information comprises a "unique identifier", it is unquestionably the case that the demographic information is not a "unique identifier associated with the content object included within the generated Web page." Instead, the demographic information is associated with a particular user. There is no teaching in Thomas that particular demographic information will always result in the selection of the same content object or is associated with a particular content object such that it comprises a unique identifier. More importantly, the "unique identifier" of Claim 1 is generated "via a hashing function." The Final Action does not even attempt to explain how demographic information could be generated via a hashing function, and Appellants respectfully submit that it is obvious that it could not be generated in such a fashion. Thus, the fact that the demographic information of Thomas cannot comprise the "unique identifier" of Claim 1 provides a second, independent basis for withdrawal of the pending rejections of the Group I claims.

As shown above, the cited references, even when combined, fail to disclose several of the recitations of independent Claim 1. The cited references also cannot properly be combined as set forth in the rejections. For each of these reasons, the Final Action fails to establish *prima facie* rejections under 35 U.S.C. § 103. Moreover, each of the remaining Group I claims include each of the above-discussed recitations of Claim 1. Accordingly, all of the Group I claims are also patentable over the cited art for at least the reasons that Claim 1 is patentable. Therefore, Appellants respectfully request that the rejections of the Group I claims be reversed.

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 12

---

### **III. The Group II Claims are Patentable Over the Cited References**

The Group II claims are Claims 2, 9, 13, 18, 25, 29, 34, 41 and 45. Each of these claims depend from a Group I claim, and thus are patentable based on the same reasons, discussed above, that the Group I claims are patentable over the cited art. In addition, each of the Group II claims recites that "the record of the request includes information that identifies the user." The Final Office Action cites to Col. 4, lines 23-52 and 49-58 of Thomas as teaching the recitation of the Group II claims. (See, e.g., Final Office Action at 4). While the cited portion of Thomas states that the user is identified, nowhere does it state that the identity of the user is included in a record of a request for a web page. Accordingly, each of the Group II claims are patentable over the cited art for at least this additional reason.

### **IV. The Group III Claims are Patentable Over the Cited References**

The Group III claims are Claims 5, 11, 16, 21, 27, 32, 37, 43 and 48. Each of these claims depend from a Group I claim, and thus are patentable based on the same reasons, discussed above, that the Group I claims are patentable over the cited art. In addition, each of the Group III claims recites "analyzing a plurality of stored user request records to determine Web content preferences of a user." The Final Office Action states that paragraph 0059 of Durst teaches the recitation of the Group III claims. (Final Office Action at 5). While the cited portion of Durst discusses determining the name and "other useful information relating to users who have accessed its web site", Durst does not teach or disclose analyzing stored user request records "to determine Web content preferences of a user" as recited in the Group III claims. Accordingly, the Group III claims are independently patentable over the cited art for at least this additional reason.

In re: Nguyen et al.  
Serial No.: 09/207,945  
Filed: December 9, 1998  
Page 13

**V. Conclusion**

In light of the above discussion, Appellants submit that each of the pending claims is patentable over the cited art and, therefore, request reversal of the rejections of Claims 1-48.

Respectfully submitted,



D. Randal Ayers  
Registration No. 40,493

USPTO Customer No. 20792  
Myers Bigel Sibley & Sajovec, P.A.  
Post Office Box 37428  
Raleigh, North Carolina 27627  
Telephone: (919) 854-1400  
Facsimile: (919) 854-1401

**CLAIMS APPENDIX**  
**USSN 09/207,945**  
**Filed December 9, 1998**

1. A method of associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the method comprising the following steps performed by the Web server:

- storing a record of the user request within a Web server log;
- generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;
- serving the generated Web page to the Web client; and
- appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

2. A method according to Claim 1 wherein the record of the request includes information that identifies the user.

3. A method according to Claim 1 wherein the step of generating the requested Web page comprises the steps of:

- retrieving a layout template for the requested Web page, wherein the layout template defines how the content object is displayed within the requested Web page;
- retrieving the content object; and
- combining the content object and the layout template to produce the requested Web page.

4. A method according to Claim 3 wherein the content object is selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

5. A method according to Claim 1 further comprising the step of analyzing a plurality of stored user request records to determine Web content preferences of a user.



Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 2

6. A method according to Claim 1 further comprising the step of appending the stored record of the user request with a time stamp for a subsequent user request for a Web page.

7. A method according to Claim 6 further comprising the step of determining a length of time the user views the generated Web page using time stamps within the stored record.

8. A method of associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the method comprising the following steps performed by the Web server:

- storing a record of the user request within a Web server log;
- generating the requested Web page, wherein the generated Web page includes first and second content objects having respective unique first and second identifiers associated therewith, wherein the unique first and second identifiers are generated via a hashing function, comprising the steps of:

- retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;
- retrieving the first and second content objects; and
- combining the first and second content objects and the layout template to produce the requested Web page;
- serving the generated Web page to the Web client; and
- appending the stored record of the user request with the first and second unique identifiers associated with the first and second content objects included within the generated Web page.

9. A method according to Claim 8 wherein the record of the request includes information that identifies the user.

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 3

10. A method according to Claim 8 wherein the first and second content objects are selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

11. A method according to Claim 8 further comprising the step of analyzing a plurality of stored user request records to determine Web content preferences of a user.

12. A method of collecting information about the preferences of Web site visitors comprising the step of:

associating dynamically generated Web page content with a user who requests a Web page from a Web server via a Web client in communication with the Web server, comprising the following steps performed by the Web server:

storing a record of the user request within a Web server log;

generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

serving the generated Web page to the Web client; and

appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

13. A method according to Claim 12 wherein the record of the request includes information that identifies the user.

14. A method according to Claim 12 wherein the step of generating the requested Web page comprises the steps of:

retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;

retrieving the content object; and

combining the content object and the layout template to produce the requested Web page.

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 4

15. A method according to Claim 14 wherein the content object is selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

16. A method according to Claim 12 further comprising the step of analyzing a plurality of stored user request records to determine Web content preferences of a user.

17. A system for associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, comprising:

means for storing a record of the user request within a Web server log;

means for generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

means for serving the generated Web page to the Web client; and

means for appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

18. A system according to Claim 17 wherein the record of the request includes information that identifies the user.

19. A system according to Claim 17 wherein the means for generating the requested Web page comprises:

means for retrieving a layout template for the requested Web page, wherein the layout template defines how the content object is displayed within the requested Web page;

means for retrieving the content object; and

means for combining the content object and the layout template to produce the requested Web page.

20. A system according to Claim 19 wherein the content object is selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 5

21. A system according to Claim 17 further comprising means for analyzing a plurality of stored user request records to determine Web content preferences of a user.

22. A system according to Claim 17 further comprising means for appending the stored record of the user request with a time stamp for a subsequent user request for a Web page.

23. A system according to Claim 22 further comprising means for determining a length of time the user views the generated Web page using time stamps within the stored record.

24. A system for associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, comprising:

means for storing a record of the user request within a Web server log;

means for generating the requested Web page, wherein the generated Web page includes first and second content objects having respective unique first and second identifiers associated therewith, wherein the unique first and second identifiers are generated via a hashing function, comprising:

means for retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;

means for retrieving the first and second content objects; and

means for combining the first and second content objects and the layout template to produce the requested Web page;

means for serving the generated Web page to the Web client; and

means for appending the stored record of the user request with the first and second unique identifiers associated with the first and second content objects included within the generated Web page.

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 6

25. A system according to Claim 24 wherein the record of the request includes information that identifies the user.

26. A system according to Claim 24 wherein the first and second content objects are selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

27. A system according to Claim 24 further comprising means for analyzing a plurality of stored user request records to determine Web content preferences of a user.

28. A system for collecting information about the preferences of Web site visitors comprising:

means for associating dynamically generated Web page content with a user who requests a Web page from a Web server via a Web client in communication with the Web server, comprising:

means for storing a record of the user request within a Web server log;

means for generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

means for serving the generated Web page to the Web client; and

means for appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

29. A system according to Claim 28 wherein the record of the request includes information that identifies the user.

30. A system according to Claim 28 wherein the means for generating the requested Web page comprises:

means for retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 7

means for retrieving the content object; and  
means for combining the content object and the layout template to produce the requested Web page.

31. A system according to Claim 30 wherein the content object is selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

32. A system according to Claim 28 further comprising means for analyzing a plurality of stored user request records to determine Web content preferences of a user.

33. A computer program product for associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the computer program product comprising a computer usable storage medium having computer readable program code means embodied in the medium, the computer readable program code means comprising:

computer readable program code means for storing a record of the user request within a Web server log;

computer readable program code means for generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

computer readable program code means for serving the generated Web page to the Web client; and

computer readable program code means for appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

34. A computer program product according to Claim 33 wherein the record of the request includes information that identifies the user.

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 8

35. A computer program product according to Claim 33 wherein the computer readable program code means for generating the requested Web page comprises:

computer readable program code means for retrieving a layout template for the requested Web page, wherein the layout template defines how the content object is displayed within the requested Web page;

computer readable program code means for retrieving the content object; and

computer readable program code means for combining the content object and the layout template to produce the requested Web page.

36. A computer program product according to Claim 35 wherein the content object is selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.

37. A computer program product according to Claim 33 further comprising computer readable program code means for analyzing a plurality of stored user request records to determine Web content preferences of a user.

38. A computer program product according to Claim 33 further comprising computer readable program code means for appending the stored record of the user request with a time stamp for a subsequent user request for a Web page

39. A computer program product according to Claim 38 further comprising computer readable program code means for determining a length of time the user views the generated Web page using time stamps within the stored record.

40. A computer program product for associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the computer program product comprising a computer usable storage medium having computer readable

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 9

program code means embodied in the medium, the computer readable program code means comprising:

computer readable program code means for storing a record of the user request within a Web server log;

computer readable program code means for generating the requested Web page, wherein the generated Web page includes first and second content objects having respective unique first and second identifiers associated therewith, wherein the unique first and second identifiers are generated via a hashing function, comprising:

computer readable program code means for retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;

computer readable program code means for retrieving the first and second content objects; and

computer readable program code means for combining the first and second content objects and the layout template to produce the requested Web page;

computer readable program code means for serving the generated Web page to the Web client; and

computer readable program code means for appending the stored record of the user request with the unique first and second identifiers associated with the first and second content objects included within the generated Web page.

41. A computer program product according to Claim 40 wherein the record of the request includes information that identifies the user.

42. A computer program product according to Claim 40 wherein the first and second content objects are selected from the group consisting of text files, audio files, video files, image files, and hyperlinks.



Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 10

43. A computer program product according to Claim 40 further comprising computer readable program code means for analyzing a plurality of stored user request records to determine Web content preferences of a user.

44. A computer program product for collecting information about the preferences of Web site visitors, the computer program product comprising a computer usable storage medium having computer readable program code means embodied in the medium, the computer readable program code means comprising:

computer readable program code means for associating dynamically generated Web page content with a user who requests a Web page from a Web server via a Web client in communication with the Web server, comprising:

computer readable program code means for storing a record of the user request within a Web server log;

computer readable program code means for generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

computer readable program code means for serving the generated Web page to the Web client; and

computer readable program code means for appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

45. A computer program product according to Claim 44 wherein the record of the request includes information that identifies the user.

46. A computer program product according to Claim 44 wherein the computer readable program code means for generating the requested Web page comprises:

computer readable program code means for retrieving a layout template for the requested Web page, wherein the layout template defines how content objects are displayed within the requested Web page;

Pending Claims  
USSN 09/419,814  
Filed: October 15, 1999  
Page 11

computer readable program code means for retrieving the content object; and  
computer readable program code means for combining the content object and the layout  
template to produce the requested Web page.

47. A computer program product according to Claim 46 wherein the content object is  
selected from the group consisting of text files, audio files, video files, image files, and  
hyperlinks.

48. A computer program product according to Claim 44 further comprising computer  
readable program code means for analyzing a plurality of stored user request records to determine  
Web content preferences of a user.

**EVIDENCE APPENDIX**  
USSN 09/207,945  
Filed December 9, 1998

No evidence is being submitted with this Appeal Brief pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132.

**RELATED PROCEEDINGS APPENDIX**

USSN 09/207,945

Filed December 9, 1998

The present application was subject to a prior appeal to the Board of Patent Appeals and Interferences, which was assigned as Appeal No. 2004-1627. A copy of the decision in that appeal is attached hereto.

55-77-1150X  
DRA

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

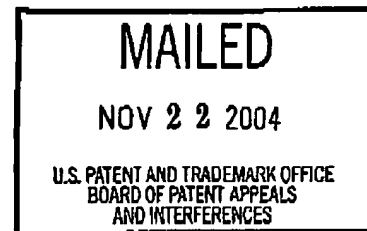
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BINH NGUYEN and SANDEEP SINGHAL

Appeal No. 2004-1627  
Application No. 09/207,945

ON BRIEF



Before DIXON, LEVY and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57, which are all of the claims pending in this application.

We reverse.

11-30-04

Appeal No. 2004-1627  
Application No. 09/207,945

### BACKGROUND

Appellants' invention is directed to a method and an apparatus for personalized content delivery to Web site visitors by dynamically generating Web page content with a user upon the request from a server by the user. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method of associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the method comprising the following steps performed by the Web server:

storing a record of the user request within a Web server log;

generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

serving the generated Web page to the Web client; and

appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

The Examiner relies on the following references:

Monier	5,974,455	Oct. 26, 1999
Wodarz et al. (Wodarz)	5,999,912	Dec. 7, 1999
		(filed May 1, 1997)
Blumenau	6,108,637	Aug. 22, 2000
		(filed Sep. 3, 1996)
Shaw et al. (Shaw)	6,311,211	Oct. 30, 2001
		(filed Jan. 14, 1999)

Appeal No. 2004-1627  
Application No. 09/207,945

Claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wodarz, Monier, Blumenau and Shaw.

We make reference to the answer (Paper No. 35, mailed February 24, 2004) for the Examiner's reasoning, and to the appeal brief (Paper No. 34, filed December 11, 2003) and the reply brief (Paper No. 36, filed March 15, 2004) for Appellants' arguments thereagainst.

#### OPINION

In rejecting the claims, the Examiner, in addition to Wodarz and Monier relies on Blumenau for teaching the step of appending the stored record of the user request with a unique URL identifier and on Shaw for logging an advertisement ID in a log file for the server process (answer, page 5). Based on the teachings of these prior art references, the Examiner concludes that the skilled artisan would have found it obvious to store information about an object content in a log file since the advertisement "eligible to particular user" can be determined (id.).

Appellants point out that the combination of Blumenau and Shaw does not disclose or suggest the claimed step of "appending the stored record of the user request with the unique identifier associated with the content object included within the generated

Appeal No. 2004-1627  
Application No. 09/207,945

Web page" (brief, page 4). Appellants specifically argue that what the examiner characterizes as "appending the stored record" in Blumenau is actually a series of separate entries in the log file for each one of the multiple transferred files resulted from a request for a web page (brief, page 5 & reply brief, page 3). Additionally, Appellants point out that Shaw merely discloses a server which uses information in a member profile and/or an event log file to determine which advertisements should be directed to a particular user (brief, page 6).

In response to Appellants' arguments, the Examiner asserts that storing the record of the requested files as a "log file" in Blumenau indicates that the stored log file is not different from the claimed "appending the stored record of the user request" (answer, page 16). The Examiner further argues that the fact that Blumenau generates the requested Web page "by analyzing transactions in the log file," proves that the identifications or the information of other files are stored in the log file (answer, page 17).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598



Appeal No. 2004-1627  
Application No. 09/207,945

(Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroval, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

After reviewing Blumenau, we agree with Appellants that storing the file information as "separate" transactions in the

Appeal No. 2004-1627  
Application No. 09/207,945

log file, as disclosed by Blumenau, is different from the claimed appending the stored record. Blumenau generates a display of the Web page requested by a user while a record of the requests for files is stored on the server (col. 2, lines 29-35). However, this stored record of the requests, or the log file, refers to a number of transactions which individually include multiple fields for storing predefined type of information about the requested file (col. 2, lines 37-44). Therefore, what the Examiner characterizes as the claimed "appending the stored record" in Blumenau (answer, page 17), actually relates to storing additional or new transactions in the log file (col. 3, lines 1-3) which presents no useful correspondence between the number of transactions in a log file and the number of times an advertisement has been visited on a Web page (col. 3, lines 4-15). This problem is what Blumenau solves by identifying and eliminating the "redundant" transactions from the log file in order to obtain a more accurate "hit count" (col. 3, lines 16-25). Therefore, as pointed out by Appellants (reply brief, page 3), although Blumenau includes items or fields in the log file for each transferred file, additional information are added to the log file as new transaction records instead of appending a stored record.

Appeal No. 2004-1627  
Application No. 09/207,945

Shaw, on the other hand, provides advocacy messages or advertisements to users based on the information stored in a member profile (col. 4, lines 39-45). Although the Examiner relies on the fact that Shaw assigns an identifier to the advertisement log (col. 11, lines 56-57), we remain unconvinced that Shaw can teach or suggest the claimed "appending the stored record." In fact, in concluding that adding more transactions to the log file of Blumenau and logging an advertisement ID in the server of Shaw provide the necessary teaching and suggestion for arriving at the claimed subject matter in claim 1, the Examiner attempts to forge a combination of an evaluation system by eliminating redundant hit counts that has nothing to do with a system for distributing specific advertisements to each user.

Thus, assuming, arguendo, that it would have been obvious to combine Wodarz, Monier and Blumenau with Shaw, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed "appending the stored record of the user request." We note that all the other independent claims, similar to claim 1, require "appending the stored record of the user request," in addition to other features. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we cannot sustain the 35 U.S.C. § 103 rejection of claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 over Wodarz, Monier, Blumenau and Shaw.

Appeal No. 2004-1627  
Application No. 09/207,945

## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 under 35 U.S.C. § 103 is reversed.

REVERSED

*J. ph. L. 10/1*

JOSEPH L. DIXON  
Administrative Patent Judge

STUART S. LEVY

STUART S. LEVY  
Administrative Patent Judge

Makshid D. Sadat

MAHSHID D. SAADAT  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

MDS / RWK

Appeal No. 2004-1627  
Application No. 09/207,945

MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH, NC 27627